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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,163	12/07/2001	Ulrich Klar	SCH 1814	5068
23599	7590	06/18/2004	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			ROBINSON, BINTA M	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/913,163	<b>Applicant(s)</b> KLAR ET AL.	
	<b>Examiner</b> Binta M. Robinson	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### Detailed Action

Claims 1-21 and 23 are pending

The restriction requirement made at paper no. 9 is modified to read on the compound of formula I where in X is 2-methyl-4thiazolyl or 2-methyl-4-oxazolyl, R1a and R1b come together to form a trimethylene group, R4 is H, C1-C10 alkyl, aryl, C7-C20 aralkyl, R5 is H, C1-C10 alkyl, aryl, C7-C20 aralkyl, R6 and R7 are H, together mean an additional bond to result in a double bond on the ring between their two positions or together mean an oxygen to provide an epoxide ring, R8 means a methyl group or hydrogen, R2 means a phenyl or benzyl or methyl, ethyl or propyl, a pharmaceutical composition, and a method for preparing a pharmaceutical agent. The applicant traverses the restriction requirement. However, these epitholione compounds change uses when the X moiety changes and when the R1a and R1b moieties change. When these epitholione compounds have a X that is 2-methyloxazolyl, and R1a and R1b are each alkyl, they can be pharmaceutical compositions used in the treatment of proliferative diseases or angiogenesis. (WO2004012735) Epitholione compounds where X is Thiazolidine and where R1a and R1b are each alkyl can be used to treat brain diseases associated with proliferative diseases— which is different from treating the actual proliferative diseases. (US 20041019088). Compounds where x is 2-methylthiazolyl and R1a and R1b come together to form a trimethylene can be used in the treatment of chronic inflammatory diseases. Compounds where the X is 2-methylthiazolyl and R1a and R1b are alkyl have uses as synthetic epitholione analog that are synthetic preparations can be used in the treatment of special cancers with

multidrug resistant phenotype. US 2002058817. When X is pyridyl and R1a and R1b are alkyl, the compound can have a different use as a diagnostic probe for elucidating active pharmacokinetic mechanisms. (See WO 2001066154). Compounds where R1a and R1b are trimethylene and X is pyridyl can be used in treating arthritis. Therefore, because compounds in each of these groups can have different uses with a change in structure, the restriction is proper. The restriction is made FINAL.

Claims 1-21 and 23 are objected to because they contain non-elected subject matter.

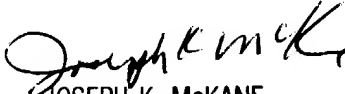
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.

BMR  
June 10, 2004

  
JOSEPH K. MCKANE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

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